

REMARKS

Non-statutory Double Patenting Rejections:

The Examiner has rejected claims 1, 2, 13, and 14 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5, 6, and 18 of U.S. Patent No. 6,381,238. The Examiner has asserted that although the claims are not identical, they are not patentably distinct. Without acquiescing to the rejection, Applicant is prepared to submit a terminal disclaimer over U.S. Patent No. 6,381,238 that complies with the requirements of 37 C.F.R. §1.321, upon withdrawal of the remaining grounds of rejection.

MPEP §2106 rejections:

The Examiner has rejected claims 1, 13, and 15 under MPEP §2106 due to informalities.

Specifically, claims 1 and 15 have been rejected for reciting a limitation “capable of”. Claim 15 has been amended to remove the limitation “capable of”. Claim 1, line 13, has not been amended because it does not recite the limitation “capable of”. Applicant respectfully disagrees that the use of “capable of” in Claim 15 suggests that the structure is optional. On the contrary, the language requires that the switch fabric includes the structure necessary to meet the claimed transfers. However to expedite prosecution, Applicant has changed the language to remove the disputed term.

Claim 13 has been amended to correct the lack of antecedent basis.

Applicant requests that the rejections be withdrawn because the claims 1, 13 and 15 now comply with the MPEP §2106.

35 U.S.C. §103 rejections:

The Examiner has rejected claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over Benayoun et al, U.S. Patent 5,959,992 in view of Li et al, U.S. Patent 6,195,714. Applicant respectfully disagrees and traverses the rejections.

Regarding claim 1, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 in Benayoun and the echo cancellation for circuit-based signals in Li (pg. 5 of the Office Action). Applicant respectfully disagrees.

As set out below, Benayoun teaches away from the suggested combination and, even if the combination is made, the claimed invention does not result from such combination. The test for obviousness is whether combined teachings render the claimed subject matter obvious. *In re Wood*, 599 F.2d 1032 (C.C.P.A., 1979). Li teaches a TDM peripheral 36a which includes the functions of STM to ATM call conversion, echo cancellation, silence suppression, etc. (Li, col. 6, lines 17-39). Benayoun does not teach that multiple functions may be incorporated into one brick 10. On the contrary, Benayoun teaches that certain functions, such as an echo canceller, are dedicated to specific bricks (col. 21, lines 27-29, 46-48). It further emphasizes that one of the invention's advantages over prior art is its modularity (col. 5, line 58). Therefore, Benayoun teaches *away* from incorporating the TDM peripheral 36a of Li.

Even if Li was incorporated into Benayoun the combination does not amount to the current invention because Li does not teach echo-cancellation on circuit-based signals. Li teaches the TDM peripheral 36a receives the STM call, performs various functions, including echo cancelling, then finally outputs an ATM call to the ATM switch fabric 22a. Li is silent regarding whether the echo cancelling is performed on the STM call or the ATM call. Therefore, even if Benayoun and Li were combined, the combination does not amount to the current invention.

As the Examiner has not established a prima facie case of obviousness, the 35 U.S.C. §103(a) rejection of claim 1 should be withdrawn and the claim passed to allowance.

Regarding claim 2, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 in Benayoun and the echo cancellation for circuit-based signals in Li (pg. 5 of the Office Action). For the same reasons asserted for claim 1, the 35 U.S.C. §103(a) rejection of claims 2 should be withdrawn and the claim passed to allowance.

Regarding claim 3, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 in Benayoun and the echo cancellation for circuit-based signals in Li (pg. 5 of the Office Action). For the same reasons asserted for claim 1, the 35 U.S.C. §103(a) rejection of claims 3 should be withdrawn and the claim passed to allowance.

Regarding claim 13, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 in Benayoun and the echo cancellation for circuit-based signals in Li (pg. 5 of the Office Action). For the same reasons asserted for claim 1, the 35 U.S.C. §103(a) rejection of claim 13 should be withdrawn and the claim passed to allowance.

Regarding claim 15, the Examiner has asserted that it would have been obvious to one of ordinary skill to combine the echo cancellation function in the echo cancellation brick 1440 into the interface brick 1435 in Benayoun and the echo cancellation for circuit-based signals in Li (pg. 5 of the Office Action). For the same reasons asserted for claim 1, the 35 U.S.C. §103(a) rejection of claim 15 should be withdrawn and the claim passed to allowance.

Likewise, the rejections for dependent claims 4-12, 14 and 16-18 should be withdrawn and the claims passed to allowance.

Applicant's discussion of particular positions of the Examiner does not constitute a concession with respect to any positions that are not expressly contested by the Applicant. Applicant's emphasis of particular reasons why the claims are patentable does not imply that there are not other sufficient reasons why the claims are patentable.

CONCLUSION

In view of the foregoing remarks and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. If the examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned.

Respectfully submitted,

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